

**STATEMENT UNDER 37 CFR 3.73(b)**

Applicant/Patent Owner: MARVIN A. ORNSTEIN

Application No./Patent No.: 09 506,458 / RE 37,588 Filed/Issue Date: 17 FEB, 2000 / 19 MAR, 2002

Entitled: GAMING SYSTEM AND METHOD FOR MULTIPLE PLAY

MAO, INC.

(Name of Assignee)

CORPORATION

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest; or
2. ☐ an assignee of less than the entire right, title and interest  
(The extent (by percentage) of its ownership interest is \_\_\_\_\_ %)

in the patent application/patent identified above by virtue of either:

- A. ☒ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel 009719, Frame 0595, or for which a copy therefore is attached.

OR

- B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

1. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at

Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

2. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at

Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

3. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at

Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

☐ As required by 37 CFR 3.73(b)(1)(i), the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11.

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

Stacey J. Perry

Signature

Nov 12, 2010  
Date

STACEY J. PERRY

Printed or Typed Name

(228) 354-8828  
Telephone Number

PRESIDENT

Title

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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IN THE UNITED STATE PATENT AND TRADEMARK OFFICE

Inventor(s): Marvin A. Ornstein et al

Title: "GAMING SYSTEM AND METHOD FOR MULTIPLE PLAY  
WAGERING"

USSN: 09/506,458

Issued: March 19, 2002

US Patent No: RE37,588

Applicant's No. MAO-2.1

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Commissioner for Patents

OFFICE OF PETITIONS

STATEMENT  
SUPPORTING PETITION TO ACCEPT PAYMENT OF FEES  
UNDER 37 CFR  
1. 378(B)

This is a petition for the USPTO to accept delayed payment of the 11.5 year maintenance fee. A review of the USPTO patent system indicates that the patent is in a status of expiration for failure to pay maintenance fees. The Assignee of Record has not received a Notice of Fees Due. The Attorney of Record for the purposes of maintenance fees in this Patent, who does maintain a fee docketing system, did fail to notify the Assignee of Record of the maintenance fees due and/or forward any USPTO Notice(s) received on behalf of the Assignee of Record.

Attached is the affidavit of Ms. Stacey Perry, President of MAO, Inc., Assignee of the US Patent No. RE37,588, which Affidavit is incorporated herein, labeled as US Patent RE 37, 588 B-1 and referenced to. As sworn, the Assignee, MAO, Inc., did engage the Attorney of Record to aid in the prosecution and ongoing maintenance of the subject Patent. At a later date, after the subject Patent had issued, the Assignee did engage an alternate attorney to further the prosecution of its various other patents pending. At the time of the failure to pay maintenance fees for the Patent, the Attorney of Record had not changed and MAO Inc relied on the Attorney of Record's maintenance docketing system as its own.

At the directive of Mr. Morris, the new Attorney hired by MAO Inc, the Assignee did file a Change of Power of Attorney for all pending Patents. At the same time MAO Inc filed a Change of Address Form for each of its patents and patents pending. The Assignee was not advised to file USPTO form SB 47: Fee Indication Form by Mr. Morris. The foregoing facts support the Assignee's assertion that the Attorney of Record's fee docketing system was the only docketing system relied upon in the matter of this Patent. The Failure of that

fees docketing system did cause the subject unintentional and unavoidable expiration.

Attached is the affidavit of Mr. Terry Morris, an Attorney Licensed to Practice before the USPTO, in the matter of MAO Inc's Docket failure regarding US Patent No. RE37,588 which Affidavit is incorporated herein, labeled as US PATENT RE37,588 and referenced to. It is the testimony of Attorney Morris that he did not receive any USPTO Notification on behalf of the Assignee of Record in the matters of Maintenance Fees Due from the Attorneys of Record. Mr. Morris had deemed the subject file as inactive since the Issuance and Publication fees were paid, assuming that the Assignee of Record was using the Attorney of Record to maintain the Fee Docket.

It is the testimony of Ms. Perry that the Attorney of Record has not ever sent to the Assignee a severance letter, nor recommendation that USPTO form SB 47 be filed indicating another firm, attorney or party to maintain a maintenance fees docket on behalf of the Assignee.

The document attached herewith, labeled as "US Patent RE37,588 A-1", the 7.5 USPTO Maintenance Fee Reminder, stamped "Received" and marked as "Forwarded" by the Attorney of Record, evidences the accepted responsibility of the Attorney of Record.

In summary, the Attorney of Record was retained to maintain this Patent prior to reissuance and failed in its accepted responsibility, as further evidenced by a letter from the Attorney of Record to the Assignee of Record, Dated August 7, 2001, attached hereto and labeled "US Patent RE37,588 A-2".

On October 15, 2010 MAO Inc, in anticipation of 2011 budgeting Perry specifically requested Attorney Morris prepare a timeline for all future fees due for all company owned Intellectual Property (US and International). Completion of this task triggered the undersigned Attorney to discover expiration of the subject Patent together with another of the Patents maintained under the Volpe and Koenig Docket System . That same day, the Assignee was appraised of the situation.

The Assignee of Record has relied on the docketing systems of its Attorney of Record to ensure patent law compliance and maintenance to protect its Intellectual Property Rights in this Patent's history and in the history of other Patents granted by the USPTO and Foreign Patent Offices. There has not ever before been a documented failure of the Assignee's Attorney of Record's Docketing System(s).

On Tuesday October 19, the President of the Assignee of Record did contact the Attorney of Record for an explanation regarding the evident failure to properly maintain the Assignee's Maintenance Fee Docket. The Attorney of Record's

Intellectual Property Paralegal, Gayle Ruckstul, and Office Manager, Sally Pietzman, both spoke with Ms. Perry, President of the Assignee. The Office Manager promised to look into the Docketing System Failure and respond promptly with an explanation to the Assignee. To date a response has not been received from the Attorney of Record.

In good faith, we request that the Intellectual Property rights of the Assignee of Record to US Patent No. 5,788,574 be restored. Attached herewith is PTO sb/96, ensuring compliance under 37 CFR 3.73(b). The Applicants/Assignee now request that USPTO accept the enclosed check as payment in full for the Unavoidably Delayed Payment of 11.5 year Maintenance Fees and Surcharge as set forth in 1.20 (i)(1).

Respectfully submitted,



Stacey J. Perry  
President  
MAO Gaming  
1636 Popps Ferry Road, Suite 224  
Biloxi, MS 39532  
228-354-8828  
228-331-0645 fax

**Volpe  
and  
Koenig**  
P.C.



**U.S. PATENT RE37588 A-1**

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1617 John F. Kennedy Boulevard  
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INTELLECTUAL PROPERTY LAW

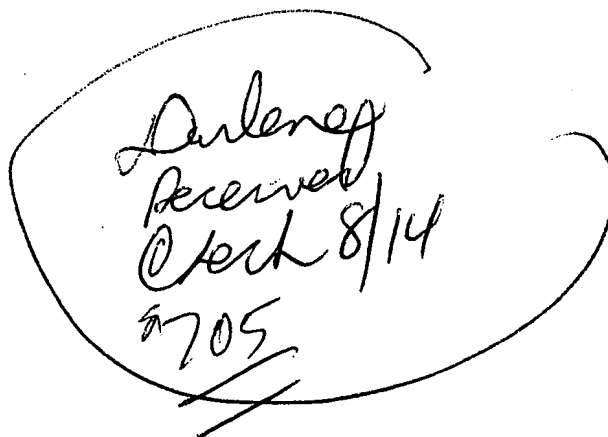
Louis Weinstein  
Senior Counsel  
lw@volpe-koenig.com



August 7, 2001

Mr. Marvin A. Ornstein  
MAO Gaming, Inc.  
605 Porter Street  
Ocean Springs, MS 39564

Re: File: MAO-PT002  
U.S. Patent No. 5,718,431  
*GAMING SYSTEM AND METHOD FOR MULTIPLE PLAY WAGERING*



Dear Marvin:

This confirms your telephone conversation of last week with Doug King, our Firm Administrator, regarding your outstanding balance and our earlier conversation concerning your failure to provide the necessary retainer as authorization to proceed with payment of the maintenance fee on this file.

If you are interested in paying the maintenance fee on this file, your retainer check in the amount of \$705 must be received prior to August 15, 2001. In accordance with your voice mail message to Doug King of today, we understand that you have mailed a retainer check in the amount of \$705. If we receive this retainer check in the amount of \$705 prior to August 15, 2001, we will attend to payment of this maintenance fee.

If your payment is not received by August 15, 2001, we will receive a maintenance fee reminder from the U.S. Patent and Trademark Office (USPTO), a copy of which will be forwarded with a copy of this letter. This USPTO reminder will set forth the information for paying the maintenance fee within the six (6) months grace period.

If you are interested in paying the maintenance fee within that grace period, **it must be paid by February 17, 2002** with the required maintenance fee payment and late fee payment totaling \$1,010. If the maintenance fee is not paid by February 17, 2002 the patent will



Mr. Marvin A. Ornstein  
Page 2

August 7, 2001  
MAO-PT002

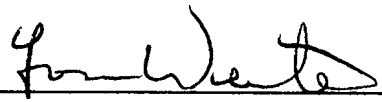
expire and become unenforceable. Upon receipt of the USPTO Notice of Patent Expiration we will forward a copy to you with a copy of this letter, close our file, and remove this matter from our docketing and follow-up systems.

In the absence of your \$705 retainer check prior to August 15, 2001, or \$1,010 prior to February 15, 2002, as authorization to proceed with payment of the maintenance fee, we will do nothing further.

We look forward to receiving your retainer check.

Very truly yours,

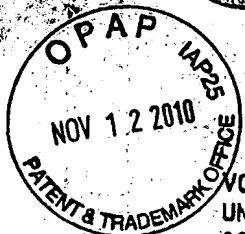
Volpe and Koenig, P.C.

By   
Louis Weinstein, Esquire

LW/ger



LO  
Cree



MAO-PT002- Transferred  
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www.uspto.gov

PAYOR NUMBER  
3624

VOLPE AND KOENIG, P.C.  
UNITED PLAZA, SUITE 1600  
30 SOUTH 17TH STREET  
PHILADELPHIA PA 19103

P75M

SEP 22 2005

DATE PRINTED

09/07/05

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# MAINTENANCE FEE REMINDER

According to the records of the U.S. Patent and Trademark Office (USPTO) the maintenance fee for the patent(s) listed below (for which the above address is on record as the fee address under 37 CFR 1.363) has not been paid within the six-month period set forth in 37 CFR 1.362(d). **THE MAINTENANCE FEE MAY STILL BE PAID WITH THE APPLICABLE SURCHARGE SET FORTH IN 37 CFR 1.20(h), WITHIN THE SIX-MONTH GRACE PERIOD SET FORTH IN 37 CFR 1.362(e).**

Unless payment of the maintenance fee and the applicable surcharge is received in the USPTO within the six-month grace period, **THE PATENT WILL EXPIRE AS OF THE END OF THE GRACE PERIOD.** 35 U.S.C. 41(b).

The total payment due is the amount required on the date the fee is paid (and not necessarily the amount indicated below). All USPTO fees (including maintenance fees) are subject to change. Customers should refer to the USPTO Web site ([www.uspto.gov](http://www.uspto.gov)) or call the Maintenance Fee Branch at 703-308-5068/5069 for the most current fee amounts for the correct entity status before submitting payment. The total payment due indicated below is based on the entity status according to current Office records (shown below).

Timely payment of the total payment due is required in order to avoid expiration of the patent. A maintenance fee payment can be timely made using the certificate of mailing or transmission procedure set forth in 37 CFR 1.8.

571 272 6500

PATENT NUMBER	FEE MAINT. AMT SURCHG	U.S. APPL NUMBER	PATENT ISSUE DATE	APPL. FILING DATE	PAY- MENT YEAR	SMALL ENTITY?	TOTAL PYMT DUE	ATTORNEY DOCKET NUMBER
RE37588 (5718431)	1150 65 -----	09506458 08804299	03/19/02 (02/17/98)	02/17/00 02/21/97	8 8	YES ----	1215 ---	ORN 3.0-002 REISSUE

(Feb 16<sup>th</sup>)

The maintenance fee and the applicable surcharge can be paid quickly and easily over the Internet at [www.uspto.gov](http://www.uspto.gov) by electronic funds transfer (EFT), credit card, or USPTO deposit account payment methods. The mailing address for all maintenance fee payments not electronically submitted over the Internet is: United States Patent and Trademark Office, P.O. Box 371611, Pittsburgh, PA 15250-1611.

Direct any questions about this notice to: Mail Stop M Correspondence, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

**NOTE:** This notice was automatically generated based on the amount of time that elapsed since the date a patent was granted. It is possible that the patent term may have ended or been shortened due to a terminal disclaimer that was filed in the application. Also, for any patent that issued from an application filed on or after June 8, 1995 containing a specific reference to an earlier filed application or applications under 35 U.S.C. 120, 121, or 365(c), the patent term ends 20 years from the date on which the earliest such application was filed, unless the term was adjusted or extended under 35 U.S.C. 154 or 156. Patentee should determine the relevant patent term for a patent before paying the maintenance fee.

703-308-4357  
571 272 1000

AFFIDAVIT OF Stacey J. PerryRECEIVED  
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STATE OF MISSISSIPPI

COUNTY OF HARRISON

Personally appeared before me the undersigned authority in and for the aforesaid jurisdiction the within named Stacey J. Perry, who, after being duly sworn, stated under oath that the following is true and correct to the best of her knowledge, information and belief.

1. I am the President of MAO, Inc. and have been since October 10, 2001.
2. MAO Inc, is the Assignee of Record for US Patent RE37,588
3. In 1995, MAO, Inc. retained Attorney Lou Weinstein, who later became a member of the law firm Volpe and Koenig to register, protect and maintain a fee docket for its intellectual property. In November of 2001, Volpe and Koenig sent their notice to MAO that the first maintenance fee was due before August 15, 2001. The correspondence is attached hereto as Exhibit A-1.
4. In October of 2004 MAO Inc engaged Attorney Terry B. Morris, Registration Number 32,345, to further the prosecution of MAO's patents pending but not to maintain a maintenance fee docket. At Attorney Morris' directive, a Change of Attorney Form for all company Patents pending was filed with the USPTO. About that time MAO Inc. moved its offices, so a change of correspondence address for all Patents and patents pending was also filed with the USPTO.
5. MAO Inc has not ever been directed by Volpe and Koenig to file USPTO Form SB47: USPTO Change of Fee Notification Address. Nor, has MAO Inc ever received a Severance Letter from Volpe and Koenig.
6. Volpe and Koenig does maintain a fees docketing system and has a paralegal specifically assigned to maintaining that system.



7. Volpe and Koenig did forward a notification of Fees Dues for this Patent in 2005, resulting in the payment of the 7.5 year maintenance fees for US Patent RE37,588. (Attachment hereto labeled A-2).

8. Volpe and Koenig was listed on August 17, 2009 as Attorney of Record for US Patent RE37,588. Volpe and Koenig failed to notify MAO Inc of the 11.5 yr. Maintenance Fee due and therefore caused the unintentional and unavoidable failure to pay 11.5 year maintenance fees.

9. In consideration of MAO's 2011 budget, on October 15, 2010, I requested that Attorney Morris create a listing of all future annuity due dates and anticipated Patent Office Actions. That very day MAO learned that US Patents 5,788, 574 and US. Patent RE37, 588 had both expired.

10. On October 19, I did contact the office of Volpe and Koenig. I spoke with both, Gayle Ruchstul (the Paralegal responsible for the client Fee Docketing System) and Sally Pietzman, the Office Manager. The paralegal immediately recognized me as a client and referred me to the Office Manager, to whom I inquired as to the cause of the fee payment failure. She took the patent numbers, their file numbers and denoted that either she or one of the Attorneys would get back to me. To date, there has been no response from Volpe and Koenig. The failure to respond to my inquiry is problematic, causing a week delay in filing Petitions to Revive Under CFR 1.378.

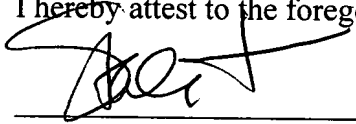
11. For the Record, MAO Inc. has filed simultaneously another USPTO Petition to Revive under CFR 1.378 for US. Patent 5,788,574.

11. The office of MAO, Inc has been located at 1636 Popps Ferry Road since April 17, 2002. To date MAO Inc, or its principals, officers, or employees have not received any notifications regarding maintenance fees or patent expiration in this matter.

12. Attorney Morris states that he has not received any communication regarding maintenance fees in this application.

13. Contrary to the apparent expiration of the subject Patent, MAO, Inc did act responsibly by hiring a patent law firm that did maintain a fee docketing system for its clients. The fact that MAO Inc hired Attorney Morris to continue prosecution of Patents Pending filed by Volpe and Koenig had no effect on the monitoring of Patents issued wherein Volpe and Koenig remained Attorney of Record and had accepted reminder docket responsibility. MAO Inc had no evidence that using Volpe and Koenig as an external fee docking system would fail. Therefore the failure to pay maintenance fees was clearly unintentional and unavoidable.

I hereby attest to the foregoing, on this 28<sup>th</sup> day of October, 2010.

  
\_\_\_\_\_

By: Stacey J. Perry



# US PATENT RE37,588 B-2

IN THE UNITED STATE PATENT AND TRADEMARK OFFICE

Inventor(s): Marvin A. Ornstein et al  
Title: "GAMING SYSTEM AND METHOD FOR MULTIPLE PLAY  
WAGERING"  
USSN: 09/506,458  
Issued: March 19, 2002  
US Patent No: RE37,588  
Applicant's No. MAO-2.1

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To the Commissioner for Patents:

## DECLARATION OF TERRY B. MORRIS


Terry B. Morris hereby declares that:

1. I am Terry B. Morris, registered patent attorney under Registration Number 32,345.
2. I have been retained by MAO, Inc., to represent it on various patent matters since 2004, dealing primarily with patent prosecution and potential litigation, but not for maintenance fee docket purposes.
3. During my handling of patent matters for MAO, Inc., I considered US Patent RE37,588 as inactive for the purposes of my representation since the Issuance and Publication fees were paid and maintenance fees tracking were assumed within the activity of the Assignee of Record was using the Attorney of Record to maintain the Fee Docket.
4. I was retained by Petitioner MAO, Inc., on October 15, 2010, to prepare a timeline for all future fees due for all of MAO's intellectual property (US and International).
5. On October 15, 2010, and during this review, I learned that US Patent RE37,588 was designated on the internet records of the United States Patent and Trademark Office as expired for failure to pay maintenance fees.
6. Subsequently on October 15<sup>th</sup>, I inform Ms. Stacey Perry of MAO, Inc. of the discovered status of expiration for US Patent RE37,588.

7. I have no recollection of any notice prior to October 15, 2010, of the maintenance fees due or indication of the pending expiration or expiration of US Patent RE37,588 for failure to pay maintenance fees and, on information and belief, I do not believe that either I, personally, or my business office did receive any United States Patent and Trademark Office Notification in the matter of Maintenance Fees Due from either the United States Patent and Trademark Office or the Attorneys of Record.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and believe to be true and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 USC 1001.

So declared, this 4th day of November, 2010.



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Terry B. Morris, Reg. No. 32,345